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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/047,592	10/23/2001	Mark C. Noe	PC11074A	5755

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12/18/2002

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EXAMINER

FORD, JOHN M

ART UNIT

PAPER NUMBER

1624

DATE MAILED: 12/18/2002

6

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/042592

Applicant(s)

Nze edd

Examiner

J. M. Ford

Group Art Unit

1624

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Response

A SHORTENED STATUTORY PERIOD FOR RESPONSE IS SET TO EXPIRE ONE MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a response be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for response specified above is less than thirty (30) days, a response within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for response is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to respond within the set or extended period for response will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- ☐ Responsive to communication(s) filed on _____.
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 1-45 is/are pending in the application.
- Of the above claim(s) _____ is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☐ Claim(s) _____ is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☒ Claim(s) 1-45 are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
 - ☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been received.
 - ☐ received in Application No. (Series Code/Serial Number) _____.
 - ☐ received in this national stage application from the International Bureau (PCT Rule 1.7.2(a)).

*Certified copies not received: _____

Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
- ☐ Interview Summary, PTO-413
- ☐ Notice of References Cited, PTO-892
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Other _____

Office Action Summary

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The claims in the application are claims 1--45.

This application has been found to contain more than one invention. Therefore, restriction to one of the following distinct inventions is required:

- (I) The instances in claims 1--42 where variable A is subspecies a, b, d, g, j, m, n and o; ~~the~~ five membered rings.
- (II) The instances in claims 1 --42 where variable A is sub-species e, h and k; the six membered rings.
- (III) The instances in claims 1--42 where variable A is sub-genus c, f, ~~g~~ and l; the seven
2 membered rings.
- (IV) Claims 43--45 drawn to multiple methods of use.

Claim 1 constitutes an improper joinder of inventions as it groups together species inventions that are distinct and separately classified, and will support separate patents. Ex parte Markush, 1925 C.D. 126, provided for this claim structure were ^{the variables were} "so closely related that they would not support a series of patents". This is not the case here. Therefore, the instant generic claims constitute an improper joinder of inventions; Ex parte Reid, 105 U.S.P.Q. 251; In re Winnek, 73 U.S.P.Q. 225; In re Ruzicka, 66 U.S.P.Q. 226.

Claim 1 is extremely burdensome due to the A variables a)--o) as each is a distinct invention that will support separate patents; in that a reference for one would not be a reference for the other(s). All of the A variables cannot be examined in the limited time provided.

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Therefore, 37 CFR 1.141(a) provides for one invention per application. Some method of restricting must be arrived at. The size of the A ring has been chosen, at it produces patentably distinct variations that will support separate patents.

These distinct inventions have acquired separate status in the art, will support separate patents, and will require different fields of search for the respective inventions. Accordingly, restriction for examination purposes, as indicated, is considered proper; 35 U.S.C. 121; 37 CFR 1.141 and 37 CFR 1.142.

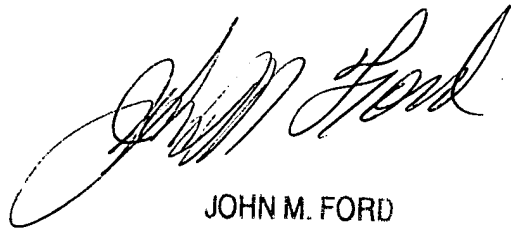
M.P.E.P. 806.05 (h) provides for restricting claims 43--45, out where it can be demonstrated that the compounds of claim 1 may be used for more than one purpose. Claims 43--45 become evidence claims to that allegation.

If Group IV is elected a further election of one specific utility is required. Claim 45 is not one specific utility, and does not meet the real world of Commerce test, as it is a laboratory test.

Applicants' response must include a provisional election, even if the requirement be traversed, see 37 CFR 1.143 and 37 CFR 1.144.

John M. Ford:jmr

December 16, 2002


JOHN M. FORD
PRIMARY EXAMINER
GROUP - ART UNIT 1624